

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

FFW

Applicant: Trevor C. McMorris et al.

Title: ILLUDIN ANALOGS USEFUL AS ANTITUMOR AGENTS

Docket No.: 103.006US5

Filed: October 27, 2003

Examiner: Leigh C Maier



Serial No.: 10/694,533

Due Date: N/A

Group Art Unit: 1614

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ A return postcard.
- ☒ A Communication Concerning Related Applications (2 pgs.).
- ☒ A Supplemental Information Disclosure Statement (2 pgs.), Form 1449 (6 pgs.), and copies of 4 cited documents.
- ☒ European Search Report from EP Application No. 04 01 2220 (5 pgs.).

Please consider this a **PETITION FOR EXTENSION OF TIME** for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
Customer Number 21186

By: William F. Prout
Atty: William F. Prout
Reg. No. 33,995

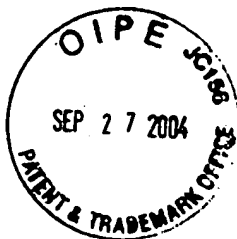
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Annika Lundberg
Name

Annika Lundberg
Signature

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
(GENERAL)

S/N 10/694,533



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Trevor C. McMorris et al.

Examiner: Leigh C. Maier

Serial No.: 10/694,533

Group Art Unit: 1614

Filed: October 27, 2003

Docket: 103.006US5

Title: ILLUDIN ANALOGS USEFUL AS ANTITUMOR AGENTS

COMMUNICATION CONCERNING RELATED APPLICATION(S)

Mail Stop Amendment
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Alexandria, VA 22313-1450

Applicants would like to bring to the Examiner's attention the following related application(s) in the above-identified patent application:

<u>Serial/Patent No.</u>	<u>Filing Date</u>	<u>Attorney Docket</u>	<u>Title</u>
08/276169 5,563,176	July 15, 1994	103.004US1	ILLUDIN ANALOGS USEFUL AS ANTITUMOR AGENTS
08/689461 5,723,632	August 8, 1996	103.005US1	TOTAL SYNTHESIS OF ANTITUMOR ACYLFULVENES
08/683687 5,932,553	July 18, 1996	103.006US1	ILLUDIN ANALOGS USEFUL AS ANTITUMOR AGENTS
09/241172 6,069,283	February 1, 1999	103.006US2	ILLUDIN ANALOGS USEFUL AS ANTITUMOR AGENTS
09/501151 6,380,403	February 9, 2000	103.006US3	ILLUDIN ANALOGS USEFUL AS ANTITUMOR AGENTS

COMMUNICATION CONCERNING RELATED APPLICATIONS

Serial Number: 10/694,533

Filing Date: October 27, 2003

Title: ILLUDIN ANALOGS USEFUL AS ANTITUMOR AGENTS

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Dkt: 103.006US5

10/134260
6,639,105

April 29, 2002

103.006US4

ILLUDIN ANALOGS USEFUL
AS ANTITUMOR AGENTS

Respectfully submitted,

TREVOR C. MCMORRIS ET AL.

By Applicants' Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6968

Date

Sept 22, 2004

By

William F. Prout

William F. Prout

Reg. No. 33,995

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Name

ANNEKA LUBER

Signature

William F. Prout

S/N 10/694,533



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Trevor C. McMorris et al.	Examiner:	Leigh C Maier
Serial No.:	10/694,533	Group Art Unit:	1614
Filed:	October 27, 2003	Docket:	103.006US5
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SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
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P.O. Box 1450
Alexandria, VA 22313-1450

In compliance with the duty imposed by 37 C.F.R. § 1.56, and in accordance with 37 C.F.R. §§ 1.97 *et. seq.*, the enclosed materials are brought to the attention of the Examiner for consideration in connection with the above-identified patent application. Applicants respectfully request that this Supplemental Information Disclosure Statement be entered and the documents listed on the attached Form 1449 be considered by the Examiner and made of record. Pursuant to the provisions of MPEP 609, Applicants request that a copy of the 1449 form, initialed as being considered by the Examiner, be returned to the Applicants with the next official communication.

Pursuant to 37 C.F.R. § 1.97(b), it is believed that no fee or statement is required with the Supplemental Information Disclosure Statement. However, if an Office Action on the merits has been mailed, the Commissioner is hereby authorized to charge the required fees to Deposit Account No. 19-0743 in order to have this Supplemental Information Disclosure Statement considered.

Pursuant to 37 C.F.R. § 1.98(d), copies of the listed documents are not provided as these references were previously cited by or submitted to the U.S. Patent Office in connection with Applicants' prior U.S. application, Serial No. 10/134260, filed on April 29, 2002, which is relied upon for an earlier filing date under 35 U.S.C. § 120.

In addition, Applicant's enclose for the Examiner's information a copy of a European Search Report for EP Application No. 04012220 in Applicants' corresponding foreign patent application. The listed documents are not provided as these references were previously cited by or submitted to the U.S. Patent Office in connection with Applicants' prior U.S. application, Serial No. 10/134260, filed on April 29, 2002.

The Applicant's however enclose documents from European Published Patent 0915819B1 and two non patent literature documents for MCMORRIS, T. C., et al., "Hydroxymethyl Acyfulvene: An Illudin Derivative with Superior Antitumor Properties", 125 (15), (Oct. 7, 1997),1251 and MCMORRIS, T. C., et al., "Metabolism of Antitumor Acyfulvene by Rat Liver Cytosol", Biochemical Pharmacology, 57, (1999),pp. 83-88. There documents were not submitted with Applicants' prior U.S. application, Serial No. 10/134260, filed on April 29, 2002.

The Examiner is invited to contact the Applicants' Representative at the below-listed telephone number if there are any questions regarding this communication.

The present application is either a U.S. national patent application filed after June 30, 2003 or an international application that entered the national stage under 35 U.S.C. § 371 after June 30, 2003. Thus, Applicant believes that the U.S. Patent & Trademark Office has waived the requirement under 37 C.F.R. 1.98 (a)(2)(i) for submitting a copy of each cited U.S. patent and each U.S. patent application publication. The waiver is provided in a pre-OG notice from the U.S. Patent & Trademark Office entitled "Information Disclosure Statements May Be Filed Without Copies of U.S. Patents and Published Applications in Patent Applications filed after June 30, 2003" and dated July 11, 2003. Applicant acknowledges the requirement to submit copies of foreign patent documents and non-patent literature in accordance with 37 C.F.R. 1.98(a)(2).

Respectfully submitted,

TREVOR C. MCMORRIS ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
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Minneapolis, MN 55402
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Date Sept 22, 2004 By William F. Prout
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Amelia Lubitz
Name

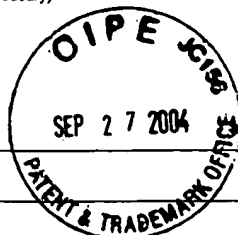
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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)



Sheet 1 of 6

Complete if Known

Application Number	10/694,533
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First Named Inventor	McMorris, Trevor
Group Art Unit	1614
Examiner Name	Maier, Leigh

Attorney Docket No: 103.006US5

US PATENT DOCUMENTS

Examiner Initial *	USP Document Number	Publication Date	Name of Patentee or Applicant of cited Document	Class	Subclass	Filing Date If Appropriate
	US-4,559,157	12/17/1985	Smith, James A., et al.	252	90	04/21/1983
	US-4,608,392	08/26/1986	Jacquet, Bernard, et al.	514	844	08/28/1984
	US-4,612,302	09/16/1986	Szabo, Sandor, et al.	514	11	11/14/1983
	US-4,684,620	08/04/1987	Hruby, Victor J., et al.	514	11	09/04/1984
	US-4,820,508	04/11/1989	Wortzman, Mitchell S.	424	59	06/23/1987
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	US-5,439,942	08/08/1995	Kelner, Michael J., et al.	514	691	10/31/1990
	US-5,523,490	06/04/1996	Kelner, Michael J., et al.	568	374	11/01/1994
	US-5,563,176	10/08/1996	Kelner, M. J., et al.	514	691	07/15/1994
	US-5,723,632	03/03/1998	McMorris, T. C.	549	331	08/08/1996
	US-5,932,553	08/03/1999	McMorris, T. C., et al.	514	23	07/18/1996
	US-6,025,328	02/15/2000	McMorris, T. C., et al.	514	2	02/20/1998
	US-6,069,283	05/30/2000	McMorris, T. C., et al.	568	374	02/01/1999
	US-6,380,403	04/30/2002	McMorris, T. C., et al.	549	330	02/09/2000
	US-6,639,105	10/28/2003	McMorris, T. C., et al.	562	3553	04/29/2002

FOREIGN PATENT DOCUMENTS

Examiner Initials *	Foreign Document No	Publication Date	Name of Patentee or Applicant of cited Document	Class	Subclass	T ²
	EP-0915819B1	05/26/2004	McMorris, T. C., et al.	C07C	49/737	
	HU-208115B	05/28/1991	Macher, Ingolf			
	JP-62-234040	10/14/1987	Shotard, Ono	C07C	49/737	
	WO-91/04754	04/18/1991	Kelner, M. J., et al.	A61K	47/48	
	WO-9104754A2	04/18/1991	Kelner, M. J., et al.	A61K	47/48	
	WO-94/18151	08/18/1994	Kelner, M. J., et al.	C07C	49/737	
	WO-94/25013	11/10/1994	Cousins, R. D., et al.	A61K	31/075	
	WO-96/34005	10/31/1996	Danishefsky, Samuel J., et al.	C07H	15/24	
	WO-97/03995	02/06/1997	Danishefsky, Samuel J., et al.	C07H	15/24	
	WO-98/03458	01/29/1998	McMorris, T. C., et al.	C07C	49/737	

EXAMINER**DATE CONSIDERED**

Substitute Disclosure Statement Form (PTO-1449)

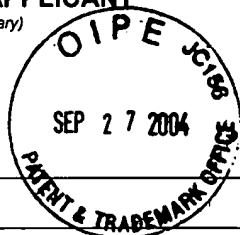
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**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

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Complete if Known

Application Number	10/694,533
Filing Date	October 27, 2003
First Named Inventor	McMorris, Trevor
Group Art Unit	1614
Examiner Name	Maier, Leigh

Sheet 2 of 6

Attorney Docket No: 103.006US5

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Foreign Document No	Publication Date	Name of Patentee or Applicant of cited Document	Class	Subclass	T ²
	WO-WO91/04754	04/18/1991	Kelner, M. J., et al.	A61K	47/48	

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		European Search Report from European Application No. 04 01 2220, dated 15 July 2004, 5 pgs	
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EXAMINER

DATE CONSIDERED

Substitute Disclosure Statement Form (PTO-1449)

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 809. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional) 2 Applicant is to place a check mark here if English language Translation is attached

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Sheet 3 of 6

Attorney Docket No: 103.006US5

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		GOLDIN, A. , et al., "Historical Development and Current Strategy of the National Cancer Institute Drug Development Program", In: <u>Methods in Cancer Research, Vol. XVI, Cancer Drug Development Part A, Chapter V</u> , Academic Press, Inc., New York,(1979),pp. 165-245	
		GREENE, T. W., <u>Protective Groups in Organic Synthesis, Chapters 4, 5 & 6</u> , John Wiley & Sons, Inc., New York,(1981),pp. 114-217	
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Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>	<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td colspan="2" style="padding: 2px;">Complete if Known</td> </tr> <tr> <td style="width: 40%; padding: 2px;">Application Number</td> <td style="padding: 2px;">10/694,533</td> </tr> <tr> <td style="padding: 2px;">Filing Date</td> <td style="padding: 2px;">October 27, 2003</td> </tr> <tr> <td style="padding: 2px;">First Named Inventor</td> <td style="padding: 2px;">McMorris, Trevor</td> </tr> <tr> <td style="padding: 2px;">Group Art Unit</td> <td style="padding: 2px;">1614</td> </tr> <tr> <td style="padding: 2px;">Examiner Name</td> <td style="padding: 2px;">Maier, Leigh</td> </tr> </table>	Complete if Known		Application Number	10/694,533	Filing Date	October 27, 2003	First Named Inventor	McMorris, Trevor	Group Art Unit	1614	Examiner Name	Maier, Leigh
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Sheet 4 of 6	Attorney Docket No: 103.006US5												

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		MATSUMOTO, TAKESHI, et al., "An Alternative Synthesis of Illudin M", <u>Tetrahedron Letters</u> , 14, (March 1970),pp. 1171-1174	
		MATSUMOTO, T., et al., "Synthesis of Illudin S", <u>Tetrahedron Letters</u> , 23, (May 1971),pp. 2049-2052	
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		MCMORRIS, T. C., et al., "Design and Synthesis of Antitumor Acylfulvenes", 62 (9), Deptt. of Chemistry and Biochemistry, University of California,(Jan.27, 1997),3015-3018	
		MCMORRIS, T. C., et al., "Fungal Metabolites. The Structures of the Novel Sesquiterpenoids Illudin -S and -M", <u>J. of Amer. Chem. Soc.</u> , 87 (7), (1965),pp. 1594-1600	
		MCMORRIS, T. C., et al., "Hydroxymethyl Acyfulvene: An Illudin Derivative with Superior Antitumor Properties", 125 (15), (Oct. 7, 1997),1251	
		MCMORRIS, T. C., et al., "Metabolism of Antitumor Acylfulvene by Rat Liver Cytosol", <u>Biochemical Pharmacology</u> , 57, (1999),pp. 83-88	
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EXAMINER

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Attorney Docket No: 103.006US5

OTHER DOCUMENTS -- NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No ¹	Include name of the author (In CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		PADWA, ALBERT , et al., "An approach toward the Illudin family of sesquiterpenes using the tandem cyclization-cycloaddition reaction of rhodium carbenoids", <u>The Journal of Organic Chemistry</u> , 62 (5), (March 7, 1997),pp. 1317-1325	
		PADWA, ALBERT , et al., "Generation and Cycloaddition behavior of spirocyclic carbonyl ylides. Application to the synthesis of the Pterisin Family of Sequiterpenes", <u>The Journal of Organic Chemistry</u> , 61 (1), (Jan. 12, 1996),pp. 73-81	
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**INFORMATION DISCLOSURE
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Complete if Known

Application Number	10/694,533
Filing Date	October 27, 2003
First Named Inventor	McMorris, Trevor
Group Art Unit	1614
Examiner Name	Maier, Leigh

Sheet 6 of 6

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		VENDITTI, J. M., "The National Cancer Institute Antitumor Drug Discovery Program, Current and Future Perspectives: A Commentary", <u>Cancer Treatment Reports</u> , 67 (9), (Sept. 1983),pp. 767-772	
		WALSER, J. , et al., "Mode of Action of Illuden S", <u>Antimicrobial Agents and Chemotherapy</u> , 3 (3), (March 1973),pp. 357-363	
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		WOLFF, MANFRED E., "Burger's Medicinal Chemistry and Drug Discovery", <u>Fifth Edition, Vol. 1: Principles and Practice</u> , 785-786	

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